

Application No.: 09/897799
Amendment dated: September 22, 2004

REMARKS/ARGUMENTS

In a telephone interview initiated by Examiner Trieu on September 21, 2004, the Examiner pointed out that the abbreviation "ASIC" in claims 13 and 22 should be spelled out in full, and that it does not appear in the specification.

The term ASIC is a well-established abbreviation for "application specific integrated circuit." See for example Patent 5,696,013 the first page and columns 1 and 2 of the specification of which are enclosed.

The amendment to the specification incorporates subject matter taken from original claim 13. As stated in Chisum on Patents, section 11.04[3], "An application's invention disclosure includes both the drawings submitted with the application on filing and the claims in the specification as originally filed. Accordingly, there is no 'new matter' bar to amendments that make the specification conform to matter disclosed in the drawings or original claims." In the footnotes, Chisum cites the following cases:

Ex parte Gould, 6 USPQ2d 1680, 1681 (BPAI 1987) "The claims in the originally-filed specification are part of the disclosure in determining compliance with Section 112 disclosure requirements."

In re Benno, 226 USPQ 683, 686-687 (Fed. Cir. 1985) "Where a patent application as filed contains a claim which specifically discloses something not disclosed in the descriptive part of the specification (claims being technically part of the 'specification' 35 U.S.C. 112 2d par.). . . the application may amend the specification without being charged with adding 'new matter' within the meaning of §132."

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Twin Disc, Inc. v. United States, 231 USPQ 417, 435 (Ct. Cl. 1986) "Although not specifically part of either the drawing or specification, the original claims in a patent application constitute a part of the 'disclosure of the invention' within the meaning of 35 U.S.C. §132."

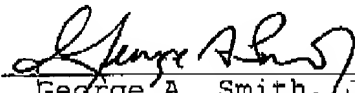
Inasmuch as the original claims are considered part of the disclosure, and the term "transponder ASIC" was in claim 13 as filed, amendment of the specification to incorporate the substance of claim 13 should be permissible.

Therefore, term "ASIC" has been replaced by "application specific integrated circuit" in claims 13 and 22, and the paragraph describing the evaluation circuit 6 has been amended by adding a sentence referring to the "transponder in the form of an application specific integrated circuit (ASIC)," i.e. the "transponder ASIC" of original claim 13. The same paragraph has been amended to refer to FIGs. 1-3 as well as FIG. 4, since the reference number 6 appears in FIGs. 1-3, but not in FIG. 4. The spelling of "realised" has been changed to the American spelling.

Favorable reconsideration and the issuance of a notice of allowance and notice of allowability are requested.

Respectfully submitted,
HOWSON & HOWSON

By


George A. Smith, Jr.

Reg. No. 24,442

Howson & Howson

Box 457

Spring House, PA 19477

Telephone: 215 540 9200

Facsimile: 215 540 5818